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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,351

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Kenji Takeda

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3918

170 7590 08/31/2007  
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EXAMINER

MCLENDON, SANZA L

ART UNIT

PAPER NUMBER

1711

MAIL DATE

DELIVERY MODE

08/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,351	<b>Applicant(s)</b> TAKEDA ET AL.	
	<b>Examiner</b> Sanza L. McClendon	<b>Art Unit</b> 1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Response to Amendment*

1. In response to the Amendment received on June 22, 2007, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 13-24. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claim 19 has been overcome by the amendment and has hereby been withdrawn for consideration.

### *Response to Arguments*

2. Applicant's arguments, see Remarks/Amendment, filed June 22, 2007, with respect to the rejection(s) of claim(s) 13 under 35 USC 102(b) as being anticipated by Wenz et al (Makromol. Chem. Rapid Commun, 3, 231-237 (1982) have been fully considered and are persuasive, thus withdrawn. Regarding the rejection of claims 13-24 under 35 USC 102 (b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Leyrer et al (4,640,960) they have been fully considered and are persuasive for newly amended claims 25-26 and 45. However they are not persuasive for claims 27-30 and 41-44 While Leyrer et al does require a sensitizer in the process, the reaction products appear to still be the same, especially in the case of using oxygen as a sensitizer—claims 27-30 and 39-45. Please find the rejection below. In addition, upon further consideration, a new ground(s) of rejection is made in view of the new matter in the amended claims and the specification, i.e., without mixing a sensitizer. The rejections are being withdrawn because, in the case of Wenz et al, Wenz et al fails to specifically teach the specific limitations of irradiating with a laser light having a wavelength within the range of 250 to 1200 nm and the average degree of polymerization of 4

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to 200. In the case of Leyrer et al, Leyrer et al fails to teach the use of sensitizers in the patented method.

### *Specification*

3. The amendment filed June 22, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: "without mixing sensitizer," on page 4 of the amendment lines 17 and 23-24. It is unclear if applicant intended for the non-use of sensitizer in the process at the time of filing the application. Please be advised that the rejection to Leyrer et al, while being withdrawn now, may be re-applied if applicant cannot provide evidence that the process was intended without mixing in sensitizers at the time of filing.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections – 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 25-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to recite, "without mixing a sensitizer". This negative limitation as recited in the amended claims did not appear in the specification as originally filed, and as such introduces new concepts which is a violation of 35 USC 112, 1<sup>st</sup> paragraph.

***Claim Rejections – 35 USC § 102/35 USC § 103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 27–30 and 41–44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leyrer et al (4,640,960).

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The courts have upheld, rejection under 35 U.S.C. 103 is indicated where prior art discloses product that appears to be either identical with or only slightly different from product claimed in product-by-process claim; Patent Office can require applicant to prove that prior art products do not necessarily or inherently possess characteristics of his claimed product; whether rejection is based on "inherency" under 35 U.S.C. 102, on "prima facie obviousness" under 35 U.S.C. 103, jointly or alternatively, burden of proof is same; Patent Office that has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may, in fact, be inherent characteristic of prior art, possesses authority to require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on.

It appears the resulting products of the method of as taught by Leyrer et al is the same as the instantly claimed diacetylene polymers. It is set forth in the disclosure that the degraded PDA's can be processed directly from the solution—see column 7. These PDA's are disclosed as being useful in the production of positive working photodegradable resists layers and dry resist films. Per example, the degraded PDA's were coated onto glass substrates that have been surface treated with aluminum. This appear to read on applicant's instant claims 29–30 and 39–40, wherein the examiner deems the glass substrate is transparent and compatible with the PDA solution since Leyrer et al has obtained imaged resist layer. Regarding claims 41–44, resist layers are known for use in optical electric devices, such as those found in claims 43–44.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of

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the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sanza L. McClendon

Examiner

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